

**REMARKS**

The above amendments and these remarks are responsive to the final Office Action issued on May 5, 2005. By this response, claims 1 and 3 are amended and claim 17 is newly added. No new matter is added. Claims 1, 3-6 and 17 are now active for examination.

The Office Action dated May 5, 2005 rejected claims 1, 3-6 and 16 under 35 U.S.C. §103(a) as unpatentable over Applicant's admitted prior art ("APA") in view of Kondo et al. (U.S. Patent No. 5,093,716). The obviousness rejection is respectfully traversed because the APA and Kondo cannot support a prima facie case of obviousness.

Claim 1, as amended, describes an image pickup apparatus including image pickup means for generating a plurality of screens having different exposure conditions, each of the generated screens having a different focal voltage. The plurality of screens are adjacent temporally and are synthesized to form a synthesized image. The image pickup apparatus further includes means for detecting the focal voltage of each of said plurality of screens and storing said detected focal voltage of each respective screen. The focal voltage contains high-frequency components included in each of said plurality of screens. Focal voltage selecting means is provided for selectively outputting the focal voltage of one of the plurality of screens that is most suited to obtain a desire focus based on a predetermined selection criterion. Appropriate support for the amendment can be found in, for example, page 13, line 5 through page 14 line 9 of the written description.

It is submitted that various features described in claim 1 are not available in APA. For instance, APA does not generate a plurality of screens having different exposure conditions, each of the generated screens having a different focal voltage. Neither does APA disclose that the image pickup apparatus includes means for detecting the focal voltage of each of said plurality of screens and storing said detected focal voltage of each respective screen, and that the

focal voltage contains high-frequency components included in each of said plurality of screens. Furthermore, the focal voltage selecting means is not available in APA to selectively output the focal voltage of one of the plurality of screens that is most suited to obtain a desired focus based on a predetermined selection criterion.

The other cited patent, Kondo, does not alleviate the deficiencies of APA. Kondo relates to a digital color video camera with auto-focus. The Office Action contended that the camera in Kondo includes a selector 30 that is purportedly comparable to the focal voltage selection means as described in claim 1. Applicants respectfully disagree.

The selector 30 in Kondo's camera is used to "couple one of the outputs supplied thereto to an output terminal 47." The outputs supplied to selector 30 include an output of an auto-focus area setting circuit 24, an auto-exposure area setting circuit 25, an automatic white balance area setting circuit 26, and a display area setting circuit 27. Thus, selector 30 is used to output one of the above-listed supplied signals, but does not "selectively [output] the focal voltage of one of the plurality of screens that is most suited to obtain a desired focus based on a predetermined selection criterion," as described in claim 1.

Additionally, Kondo fails to disclose "means for detecting the focal voltage of each of said plurality of screens and storing said detected focal voltage of each respective screen," as required by claim 1. Contrary to the contention of the Office Action, element 21 in Kondo does not include focal voltage storage means that stores a plurality of focal voltages detected from the plurality of screens obtained under different exposure conditions.

Moreover, claim 1, as amended, describes "generating a plurality of screens having different exposure conditions, each of the generated screens having a different focal voltage." It is believed that neither APA nor Kondo specifically teaches these features.

Accordingly, APA and Kondo, even if combined, do not disclose “image pickup means for generating a plurality of screens having different exposure conditions, each of the generated screens having a different focal voltage...; means for detecting the focal voltage of each of said plurality of screens and storing said detected focal voltage of each respective screen, said focal voltage containing high-frequency components included in each of said plurality of screens; and focal voltage selecting means for selectively outputting the focal voltage of one of the plurality of screens that is most suited to obtain a desired focus based on a predetermined selection criterion,” as described in claim 1.

Applicants note that in combining APA and Kondo, the Office Action alleged, in blanket, that such combination would “provide an image pick up apparatus having auto-focusing, auto-exposure control system of the accuracy and reliability of a digital arrangement which is relatively simple and compact for ready incorporation into a hand-held camera as taught in Kondo.” Despite such general allegation, however, the Office Action failed to produce evidence of specific motivations on why and how APA should be modified by Kondo, as required by well-established case law that teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The teachings, motivations or suggestions to combine references must be based on objective evidence of record and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, there must be particular finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge to the claimed invention to combine or modify references. *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The Office

Action, however, fails to provide the prerequisite motivation to combine APA and Kondo. It is respectfully submitted that the Examiner has **not** discharged his duty to establish a prima facie case of obviousness.

Since the Office Action fails to establish a prima facie case of obviousness, the obviousness rejection of claim 1 is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

Claims 3-6 depend on claim 1 and incorporate every limitation thereof. Therefore, claims 3-6 also are patentable over APA and Kondo for at least the same reasons as for claim 1, by virtue of their dependencies on claim 1.

Additionally, claims 3-6 further describe features that are unavailable in either APA or Kondo, and thus are patentable also based on their own merits. Claim 3 describes that during automatic focusing, the focal voltage selecting means continuously provides a focal voltage that is outputted at the time that the lens group is initially driven, for a period of time starting from the lens group are initially driven until a desired focus is reached, to thereby stop moving the lens group. claim 4 describes that the focal voltage selecting means selectively outputs a focal voltage for focusing in accordance with magnitudes of said stored focal voltages inputted to the focal voltage selecting means. Claim 5 describes that the focal voltage selecting means selectively outputs a focal voltage for focusing on the basis of a comparison among luminance level frequency distributions associated with the obtained screens. Claim 6 is amended and describes that the focal voltage selecting means as recited in claim 1 varies the selection criterion in accordance with magnitudes of said stored focal voltages inputted to said focal voltage selecting means and luminance level frequency distributions of the screens respectively associated with the focal voltages.

In contrast, the sections in Kando that the Office Action identified as supporting the obviousness rejection merely describe generation of a plurality of focal voltages to improve focusing performance (accuracy and speed) with respect to one focal point. Thus, Kondo fails to disclose the features of the focal voltage selecting means, as described in claims 4-6.

#### **New Claim 17 Is Patentable**

New claim 17 depends on claim 1 and further describes that the focal voltage selecting means is configured to perform a step to compare the focal voltage of each of the plurality of screens obtained under different exposure conditions, and update the focal voltage that is most suited to obtain the desired focus based on a result of the comparing step, and that the lens group drive means adjusts the focal point of said lens group based on the updated focal voltage that is most suited to obtain the desired focus. Appropriate support for claim 17 can be found in, for example, Figs. 2 and 6; page 13, line 25 through page 14, line 9, and page 18, first paragraph through page 19, first paragraph of the written description.

As discussed earlier, claim 1 is patentable over the combination of APA and Kondo. Accordingly, claim 17 also is patentable over APA and Kondo by virtue of its dependency on claim 1, as well as based on its own merits. Favorable consideration of claim 17 is respectfully requested.

#### **CONCLUSIONS**

For the reasons given above, Applicants believe that this application is conditioned for allowance and request that the Examiner give the application favorable reconsideration and permit it to issue as a patent. However, if the Examiner believes that the application can be put

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in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink that reads "Wei-Chen Chen". The signature is fluid and cursive, with a small flourish at the end.

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